REMARKS

Present Status of the Application

The office action has withdrawn the rejections of claims 1-8, 10-13 and 15 under 35 U.S.C. 102(b), as being anticipated by Bellhouse et al. (WO/94/24263) and the rejections of claims 1-15 under 35 U.S.C. 103(a) as being unpatentable over Bellhouse et al. (WO 94/24263, hereinafter Bellhouse) in view of Bhat et al. (J. Appl. Genet. 2001, 42(4) : 405-412, hereinafter Bhat).

Currently, the office action rejected claims 1-15 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Applicants have amended claims 1 and 11 to overcome the rejection. After entry of the foregoing amendments, claims 1-15 remain pending in the present application, and reconsideration of those claims is respectfully requested.

Rejections under 35 U.S.C. 112, first paragraph

The office action stated the independent claims have been amended to require that the "sample solution is free of metal particles" does not contain literal support for a method so limited. Although the specification contemplates the methods wherein biological materials are delivered through a cell membrane/wall or the skin without using metal particle carriers (see the abstract), a teaching that biological materials are delivered without using metal particles carriers

is not the same as a teaching that the sample solution used in the method must be free of metal particles.

In response thereto, applicant has amended claims 1 and 11 with deleting "sample solution is free of metal particles" and adding "the biological material is delivered without using metal particle carriers" to overcome the rejection. However, applicant has still to explain that at page 4, paragraph [0011] of the specification, "the sample of this invention is prepared in the solution form without using metal particles, ..." has been described, and thus applicant respectfully submits "sample solution is free of metal particles" should not be new matter.

In addition, the office action also stated many solvents used to prepare biological samples comprises metal particles, such as iron, magnesium, etc., which do not have the properties of metal particles carriers. As there is nothing in the disclosure that would lead one skill in the art to conclude, at the time the patent application was filed, that the description requires that the solvent used in the method be free of metal particles, support for the newly added claim limitation is not implicit in the disclosure as filed.

In response thereto, applicant respectfully disagrees with the Examiner because applicant submits that many solvents used to prepare biological samples comprises ***metal salts***, such as salts containing iron, magnesium, etc., **but not comprises metal particles** (from a textbook: Molecular Cloning, Appendix B (preparation of reagents and buffers used in molecular cloning)). Usually, the metal salts are dissolved in the solvent and thus the solvent would not include metal particles. If the metal salts are not completely dissolved in the solvent, the particles presented in the solvent are metal salt particles but not metal particles.

CONCLUSION

For at least the foregoing reasons, it is believed that the pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

Respectfully submitted,
J.C. PATENTS

Date: 9-7-2007

Jiawei Huang
Registration No. 43,330

4 Venture, Suite 250
Irvine, CA 92618
Tel.: (949) 660-0761
Fax: (949)-660-0809